

AMENDMENT UNDER 37 C.F.R. § 1.116  
U.S. Patent Application No.: 10/056,022

Attorney Docket No.: Q68273

**REMARKS**

Claims 1, 4 and 5 are all the claims pending in the application.

Claim 1 is objected to.

Claims 1, 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Che et al. (U.S. Patent No. 5,604,587) in view of Reick et al. (U.S. Patent No. 3,641,332).

The Applicants traverse the rejections and request reconsideration.

***Claim objections***

The claims have been amended to overcome the noted objections.

***Rejection of claims 1, 4 and 5 under 35 U.S.C. 103(a) based on Che et al and Reick et al.***

The present invention requires a core that is formed by an inner tube that is made of resin. The sample flows through the inner tube. The Examiner uses Reick for its alleged suggestion of such an inner tube. To the contrary in Reick, the core is made of resin only. Even if this core is hollow, the light is guided in the resin part of the core. Thus even if a hollow part is formed in the core, there is no suggestion for a fluid being filled in this hollow part.

The Applicants respectfully submit that the combined teachings of Che and Reick do not suggest the above feature.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally,

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the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2142 citing *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Further, the Applicants respectfully submit that a skilled artisan would not have been motivated to combine the teachings of Che and Reick. The cladding 38 of Che is provided to protect the capillary from degradation due to light, moisture, oxidation and environmental contaminants. The air layer of Reick does not have such functions. Therefore, a skilled artisan will not be motivated to use an air layer as a cladding layer because it does not provide such a protection function.

The Applicants respectfully submit that the patent office has not satisfied the burden of establishing *prima facie* obviousness at least because it has not satisfied at least the "all limitations" and "motivation" prongs of the three prong test for obviousness. Specifically, the patent office has not shown that the combined teachings of Che and Reick suggest the above discussed features.

Further, the Applicants respectfully submit that Reick deals with a nonanalogous art. Under US law, a determination that a reference is from a nonanalogous art is twofold: First, one must decide if the reference is within the field of the inventor's endeavor. If it is not, one proceeds to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. *In re Wood*, 202 USPQ 171 (CCPA 1979).

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Reick has nothing to do with cells for analyzing fluids or measurement techniques for fluids in general. Reick discloses an application related to fiber optics illumination, a field that has very little to do with analyzing fluids. Moreover, Reick is not pertinent to any particular problem in cells that are used for analyzing fluids. There is no disclosure in Reick related to either the problems or the claimed solutions in the field of cells for analyzing fluids. Importantly, the disclosure in Reick which the patent office cites for support do not appear to provide any motivation whatsoever.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Applicant files concurrently herewith a Petition (with fee) for an Extension of Time of one month, thereby extending the time for response to July 23, 2006. (July 23, 2006 fell on a Sunday making the filing on July 24, 2006 timely.)

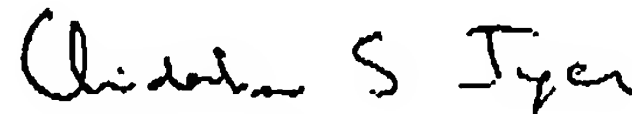
Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this application, and any required fee for such extension is to be charged to Deposit Account No. 19-4880. The Commissioner is also authorized to charge any additional fees

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under 37 C.F.R. § 1.16 and/or § 1.17 necessary to keep this application pending in the Patent and  
Trademark Office or credit any overpayment to said Deposit Account No. 19-4880.

Respectfully submitted,



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WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

Date: July 24, 2006